

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Stephen Almeida
Title: Multiple Pulse Photo-Epilator
Serial No.: 09/173,422
Patent No.: 6,228,074
Filing Date: October 15, 1998
Issue Date: May 8, 2001
Date: September 28, 2011

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-145

Sir:

PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEE IN AN EXPIRED PATENT UNDER 37 CFR §1.138 (b)

DECLARATION OF John C. Serio, ESQ.

I, John C. Serio, formerly of the firm Brown Rudnick Berlack Israels LLP, being an attorney of record for the above-referenced patent hereby swear that the expiration of the above referenced patent for failure to pay maintenance fees was unavoidable and unintentional for the following supporting reasons;

I. BACKGROUND

1. I am a citizen of the United States and am more than twenty-one (21) years of age;
2. I am presently a partner at the Law Firm of Seyfarth Shaw LLC (“Seyfarth Shaw”) (<http://www.seyfarth.com/>), where I have been practicing since May 27, 2007;

3. Before joining Seyfarth in 2007, I was Senior Counsel at the Law Firm of Brown Rudnick Berlack & Israel ("Brown Rudnick") in its Boston office from about July 1, 2000 until May 15, 2007;

4. Before joining Brown Rudnick, I was in-house Patent and Trademark Counsel to Gamera Bioscience, Medford, Massachusetts, from November 1, 1998 to April 30, 1999;

5. Before joining Gamera Bioscience, I was in private practice in Northampton, Massachusetts from about 1987 to about 1998;

6. I earned a J.D. from the Western New England School of Law in 1986, a Bachelors of Science in Pharmacy from the University of Rhode Island in 1980. I have been a member of the Commonwealth of Massachusetts Bar since about 1987 and a Registered Attorney with the U.S. Patent and Trademark Office ("PTO") since 1995 as a patent attorney (Registration No. 39,203). My practice includes Intellectual Property ("IP") law, with a focus on patent prosecution, due diligence, and freedom to use opinions in the chemical, biotechnology, and pharmaceutical arts. I also have considerable experience in Food and Drug Law;

7. On or about May 27, 2007, I accepted an offer to join my present firm, Seyfarth Shaw, in their Boston office to continue my practice in IP law;

8. I joined Seyfarth Shaw with several of my colleagues from the Boston office of Brown Rudnick;

9. In accordance with professional and ethical obligations, my colleagues and I requested that our clients instruct Brown Rudnick to transfer our client's physical and electronic files to our new firm, Seyfarth Shaw;

10. As a result of these transfer requests, Brown Rudnick transferred the physical files of our collective clients, these files amounted to the work product of several attorneys over the period of several decades and totaled in excess of 700 hundred active files and several thousand inactive files;

11. As a further result of these transfer requests, Brown Rudnick transferred the electronic files of our collective clients, these electronic files amounted to the work product of

several attorneys over the period of several decades and the respective docketing records for this collective work;

12. To ensure the orderly transfer of these files, we hired our former docketing clerk, June Kaps, who had over seventeen years of experience in the area of administration, procedure and docketing in the patent and trademark field and who had worked with us at Brown Rudnick;

13. Ms. Kaps is very experienced in patent practice and procedure and understands the importance and issues in the docketing of patent applications and issued patents;

14. Ms. Kaps is experienced in the use of electronic and manual patent systems to ensure proper docketing notice to patent practitioners;

15. Immediately upon our arrival at Seyfarth Shaw, Ms. Kaps began the process of receiving and docketing the physical files sent to us by Brown Rudnick at the request of our respective clients;

16. Our former firm, Brown Rudnick, had a professional file room manager who was responsible for ensuring the transfer of our clients' files;

17. In order to ensure that the importance of our clients' matters were protected, we contracted with the patent docketing software company, CPI, to additionally have an electronic transfer of our clients' docket entries as requested by their transfer instructions;

18. We believed that the steps taken during the transfer of files had redundancy to ensure our important client matters would be protected in the form of not only the receipt of physical files, but the receipt of corresponding electronic docket entries.

19. On or about September 1, 2011, Ms. Kaps received an email from the docketing clerk at Brown Rudnick that contained a Patent Expiration Notice for U.S. Patent 6,595,986 ("Expired Patent"). The expiration was based upon the failure to pay maintenance fees (Kaps Dec., Attachment D).

20. The Expired Patent was a CIP application of the above-captioned patent ("Petition Patent") for a client, Stephen Almeida, who had requested that Brown Rudnick transfer its files to Seyfarth Shaw on or about May 16, 2007 (Kaps Decl., Attachment B);

21. Upon receiving this Expiration Notice, Ms. Kaps brought this notice to the undersigned's attention;

22. We conducted an investigation and found that we did not possess the physical file nor the electronic file associated with this patent and that the patent was therefore not entered into our docketing system;

23. Based upon the receipt of the Expiration Notice we immediately filed a petition, under 37 CFR 1.378 (c), which was granted;

24. Shortly after receipt of the Expiration Notice, the undersigned attorney, our file room manager (Edwin Colon), and Ms. Kaps diligently searched our file room for other patents related to our client's Expired Patent.

25. During the course of our investigation we discovered that the Petition Patent for this Expired Patent was also not in our physical presence or docketing system;

26. Upon inquiry to the USPTO PAIR system we discovered that the Petition Patent had also expired for failure to pay maintenance fees. As part of our investigation, we requested the file wrapper of the Petition Patent to see where the Notice of Expiration was sent;

27. As with the Expired Patent, the Expiration Notice was sent to our former firm Brown Rudnick on or about June 8, 2009, however, this notice was not forwarded to us, as had been the case of the Expired Patent (Kaps Decl., Attachment F);

28. A double-docketing system is maintained by the undersigned attorney. One system is maintained with the aid of a computer and the other is a manual system. Accordingly, because of the failure to receive the physical or electronic files, despite our client's instructions, neither of the two docket systems recorded the existence of the Expired Patent and its related Petition Patent.

29. Since the undersigned attorney never received the physical file and its electronic counterpart, I did not receive the patent maintenance fee reminder and the subsequent Notice of Patent Expiration. Thus, I had no notice of the fees that were due. Accordingly, it is submitted that any abandonment of this application was unintentional and unavoidable and it is respectfully

requested that this Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent under 37 CFR 1.378 (b) be granted.

30. I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge and understanding that willful false statements and the like so made are punishable by fine, or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any revived U.S. patent.

Respectfully submitted,



John C. Serio
Attorney for Patentee
Seyfarth Shaw LLP
Two Seaport Lane, Suite 300
Boston, MA 02210-2028
Tel.: (617) 946-4831
Fax: (617) 946-4801